

REMARKS

Claims 19, 20, 22, 23, and 30 remain in the subject application with claim 19 in independent form. Claims 1-18, 21, and 24-29 have been previously cancelled.

Claim 19 stands objected to by the Examiner because the language “the transverse link, the longitudinal link, the triangular link, the rear-axle subframe, the stabilizer, the spring-strut support, or the shock-absorber” appears both in the preamble and in the body of claim 19. As set forth in the Manual of Patent Examining Procedure (MPEP), §2111.02 Effect of Preamble, the determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case; there is no litmus test defining when a preamble limits the scope of a claim. *See Catalina Mktg. Int’l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002).

Further, “[i]f the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is necessary to give ‘life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” *See Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). Dependence on a particular disputed preamble phrase for antecedent basis may limit claim scope because it indicates a reliance on both the preamble and claim body to define the claimed invention. *See Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, USPQ2d 1816, 1820 (Fed. Cir. 1995).

In *Catalina* (Tab 1), claim 1 recited the language “located at predesignated sites such as consumer stores” in the preamble and claim 25 recited this language in both the preamble and the body of the claim. The Court of Appeals for the Federal Circuit (CAFC) held that the

language in the preamble of claim 1 could be deleted without affecting the structural definition or operation and was not limiting. *Catalina at 810*. However, the CAFC held that since the Applicant specifically included this language, not once, but twice, once in the preamble and once in the body of the claim, claim 25 was limited by this language. *Id at 811*.

In the subject application, the language “a transverse link, a longitudinal link, a triangular link, a rear-axle subframe, a stabilizer, a spring-strut support, or a shock-absorber” appears both in the preamble and the body of claim 19. This language is necessary to give life, meaning, and vitality to the claim and to indicate that which the Applicant actually invented. The Applicant is not claiming to be the first to invent thermoplastic polyurethane (TPU) moldings or microcellular polyurethane elastomers, individually. Both TPU molding and microcellular polyurethane elastomers are known individually and have been used in various applications. However, the Applicant is claiming to have been the first to combine these into a composite damping element to be received in and to dampen and absorb vibrations of the transverse link, the longitudinal link, the triangular link, the rear-axle subframe, the stabilizer, the spring-strut support, or the shock-absorber. This language is necessary to provide the environment into which the composite damping element is received. Accordingly, the Applicant respectfully disagrees that this language is clearly a duplicate of the recitation in the preamble and as should not be deleted.

Claims 19, 20, 22, 23, and 30 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. More specifically, the Examiner contends that the term “chemically” in claim 19, line 7 appears to be new matter.

Applicant directs the Examiner's attention to page 2, lines 13-19 of the originally-filed specification wherein the TPU molding is described as being prepared having an excess of isocyanate groups. "Due to this excess of isocyanate groups, the free isocyanate groups react with the starting components for the microcellular polyurethane elastomer when these are prepared, in particular with components (b) in the preparation of (ii), giving markedly improved bonding and thus adhesion between (i) and (ii)." *See page 2, lines 21-25 of the originally-filed specification.* While the originally-filed specification does not use the term "chemically bonded", one skilled in the art, upon reading the above language, would appreciate that a chemical bond has formed between the free isocyanate groups and the microcellular polyurethane elastomer as a result of the reaction therebetween. Additional support can be found in the specification as originally filed at page 4, lines 24-30 and page 4, lines 42-46. Based upon the above, there is adequate support in the specification as originally filed to reasonably convey to one skilled in the art that the Applicant had possession of the claimed invention and the 35 U.S.C. §112 rejection is overcome.

Claims 19, 20, 22, 23, and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bauvois (United States Patent No. 5,288,442). The Examiner contends that Bauvois teaches essentially the same polyurethane foaming process and the same damping applications of the claimed invention. From this, the Examiner believes that a suitable microporous foam is taught or is an obvious optimization to one skilled in the art motivated to provide required damping properties.

More specifically, the Examiner contends that Bauvois teaches a process for the manufacture of a molded structure comprising stiffening elements and/or damping elements.

The Examiner believes that the resulting adhesion between the TPU element and the foam core is the same, whether it is chemically bonded or not. The Examiner also relies on Krech (United States Patent No. 6,063,824) for a teaching of using microcellular polyurethane elastomer for a vibration and shock damping system.

Applicant respectfully traverses the 35 U.S.C. §103(a) rejection. Applicant is not claiming a process of forming a molded article, but is claiming a composite damping element received in a transverse link, a longitudinal link, a triangular link, a rear-axle subframe, a stabilizer, a spring-strut support, or a shock-absorber. When applying 35 U.S.C. §103, the following tenets of patent law *must* be adhered to:

(A) The claimed invention *must be considered as a whole*;

(B) The references *must be considered as a whole* and must suggest the desirability and thus the obviousness of making the combination;

(C) The references must be viewed *without the benefit of impermissible hindsight* vision afforded by the claimed invention; and

(D) Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

To avoid hindsight, the Examiner must step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person. Knowledge of Applicant’s disclosure must be put aside in reaching this

determination. The tendency to resort to "hindsight" based upon Applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight *must be avoided* and the legal conclusion *must be reached on the basis of the facts gleaned from the prior art*. See MPEP §2141.

Applicant submits that the Examiner is relying on impermissible hindsight to reach a determination of obviousness and there is no suggestion, teaching, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. If one skilled in the art viewed the references without impermissible hindsight, the combination is unlikely to have resulted in a composite damping element received in a transverse link, a longitudinal link, a triangular link, a rear-axle subframe, a stabilizer, a spring-strut support, or a shock-absorber. Bauvois is directed toward forming a complex molded structure, especially a ski (*see col. 1, lines 9-10*), whereas the subject invention does not claim such a structure.

Bauvois states that the complex molded article is traditionally meant to be a molded structure comprising stiffening or reinforcing elements being in the form of wires or in the form of clothes, or even in the form of plates, protection elements, and/or various mechanical elements such as, for example, damping elements, lightening elements, and/or decoration elements (*see col. 1, lines 12-20*). Such a disclosure does not lead one skilled in the art to the claimed composite damping element to be received in the transverse link, the longitudinal link, the triangular link, the rear-axle subframe, the stabilizer, the spring-strut support, or the shock-absorber.

Further, Krech et al. discloses a process for the production of microcellular polyurethane elastomers and their use as dampening elements. Krech et al. does not provide any disclosure of composite elements comprising microcellular polyurethane elastomers chemically bonded to thermoplastic polyurethane moldings as claimed in claim 19. One skilled in the art would not be motivated to combine the teachings of Krech et al. with the disclosure of Bauvois to arrive at the claimed invention.

In addition to the above tenets, to establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and *not based on Applicant's disclosure*. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Further to the lack of suggestion or motivation described above, even if the references could be combined, the references do not teach or suggest all of the claim limitations. Specifically, Bauvois does not teach or suggest chemically bonding the foam core to the thermoplastic layer to produce the composite damping element. Referring to Figure 2 of Bauvois, a decorative element 11 is formed from multiple layers. An innermost layer is a generally described as a foam core 16 that is surrounded by a polyurethane shell 13 and an upper rigid plate 14. Reinforcing elements 9, 12, which are clothes impregnated with a resin, is positioned between the decorative element 11 and the polyurethane shell 13 and the upper rigid plate 14. The polyurethane shell 13 is impervious and capable of displaying properties of adhesion with the resin of the reinforcing elements 9, 12. An exothermic reaction occurs as the foam core 16 expands and the resin physically bonds the polyurethane shell 13, the

upper rigid plate 14, the reinforcing elements 9, 12, the decorative element 11, and the foam core 16. *See col. 3, lines 50-68.*

Bauvois does not teach or suggest preparing the polyurethane shell 13 and the rigid plate 14 having excess isocyanate groups for creating a chemical bond to the foam core 16. The polyurethane shell 13 and the upper rigid plate 14 are sealed (*see col. 4, lines 30-34*), such that the foam core 16 contacts the polyurethane shell 13 and the upper rigid plate 14 and will not separate therefrom. The interface between the foam core 16 and the polyurethane shell 13 and the upper rigid plate 14 is not required to have the same adhesion properties of the claimed invention. The foam core 16 is not repeatedly stressed and any such stresses are absorbed and damped by the polyurethane shell 13, the upper rigid plate 14, the reinforcing elements 9, 12, and the decorative element 11.

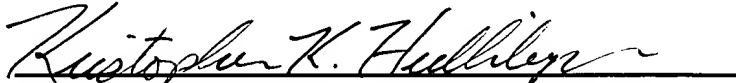
The microcellular polyurethane elastomer of the composite damping element of the subject invention repeatedly dampens and absorbs the vibrations from the transverse link, the longitudinal link, the triangular link, the rear-axle subframe, the stabilizer, the spring-strut support, or the shock-absorber. Therefore, the interface between the TPU molding and the microcellular polyurethane elastomer has to have adhesion properties sufficient to withstand such vibrations. It has been determined that the chemical bond formed according to the subject invention has a markedly improved adhesion and an improved mechanical properties (*see page 9, lines 11-16 of the originally-filed specification*). Those skilled in the art recognize that there is a significant difference between adhesion properties of a chemical bond and a physical bond.

Those skilled in the art also recognize that microcellular polyurethane elastomers are typically formed without blowing agents and as such do not rapidly expand. Therefore, even if such a combination was proper, there is no reasonable expectation of success. Specifically, Bauvois relies on expansion of the foam core 16 to force the polyurethane shell 13, the upper rigid plate 14, the reinforcing elements 9, 12, and the decorative element 11 outwardly against the mold. Bauvois is silent as to the type of foam core 16, but, those skilled in the art recognize that there are various types of foams made from plastic and made from polyols and isocyanates, such as for example, rigid polyurethane foams, semi-rigid polyurethane foams, flexible polyurethane foams, high resilience polyurethane foams, and the like. Since microcellular polyurethane elastomers are least likely to expand compared to the other foams, one skilled in the art would not make such a combination. Accordingly, Bauvois does not teach or suggest each and every limitation as claimed in claim 19 and the 35 U.S.C. §103(a) rejection is overcome.

It is respectfully submitted that the Application is presented in condition for allowance, or alternatively, in a better form for appeal. Applicant believes that no fees are due, however, if any become required, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account 08-2789. Further and favorable reconsideration of the outstanding Office Action is hereby requested.

Respectfully submitted,
HOWARD & HOWARD ATTORNEYS

07/02/04
Date


Kristopher K. Hulliberger, Registration No. 53,047
Howard and Howard Attorneys, P.C.
The Pinehurst Office Center, Suite 101
39400 Woodward Ave.
Bloomfield Hills, MI 48304-5151
(248) 723-0453

CERTIFICATE OF EXPRESS MAILING

I hereby certify that this paper or fee is being deposited with the United States Postal Service as Express mail, label no. EL 826 404 239 US postage prepaid, in an envelope addressed to Mail Stop AF Amendment, Commissioner For Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on July 2, 2004.

Melissa Dadisman
Melissa Dadisman

LEXSEE 289 F.3D 801

**CATALINA MARKETING INTERNATIONAL, INC., Plaintiff-Appellant, v.
COOLSAVINGS.COM, INC., Defendant-Appellee.**

01-1324

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

289 F.3d 801; 2002 U.S. App. LEXIS 8863; 62 U.S.P.Q.2D (BNA) 1781

May 8, 2002, Decided

SUBSEQUENT HISTORY: Motion granted by, Claim dismissed by *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 2003 U.S. Dist. LEXIS 11488 (N.D. Ill., July 2, 2003)

PRIOR HISTORY: [**1] Appealed from: United States District Court for the Northern District of Illinois. Judge John W. Darrah.

Catalina Mktg. Int'l v. Coolsavings, 2001 U.S. Dist. LEXIS 3781 (N.D. Ill. Mar. 27, 2001). *Catalina Mktg. Int'l v. Coolsavings*, 2001 U.S. Dist. LEXIS 3781 (N.D. Ill., Mar. 27, 2001)

DISPOSITION: AFFIRMED-IN-PART, REVERSED-IN-PART, VACATED-IN-PART, and REMANDED.

CASE SUMMARY:

PROCEDURAL POSTURE: Plaintiff patent owner sued defendant corporation, alleging that the corporation's web-based coupon system infringed on its patent. On summary judgment, the United States District Court for the Northern District of Illinois held that the corporation did not infringe, either literally or by equivalents, on the owner's patent. The court also applied prosecution history estoppel to bar the owner from seeking equivalents. The owner appealed.

OVERVIEW: The owner had a patented coupon system whereby coupons were dispensed to consumers at remote, kiosk-like terminals connected to a central host computer. The corporation obtained a patent for a system that was web-based. Two patent claims were at issue in the instant case. The corporation argued and the trial

court found that the phrase, "located at predetermined sites such as consumer stores," was limiting language in the preamble. In rejecting this argument, the appellate court found that the owner did not rely on the phrase to define its invention nor was the phrase essential to understand limitations or terms in the claim body. Although the specification referred to terminals located at points of sale, and even once stated that terminals might be placed in retail stores, the specification, in its entirety, did not make the location of the terminals an additional structure. The doctrine of equivalents required a factual assessment of whether the corporation's system was insubstantially different from the owner's. The owner did not surrender subject matter by making allusions to terminal location, and prosecution history estoppel did not bar the owner from seeking equivalents.

OUTCOME: The judgment of non-infringement on one claim was vacated. On a second claim, the holding of no literal infringement was affirmed, and the holding of no infringement by equivalents was vacated and remanded. The holding that prosecution history estoppel barred equivalents was reversed.

LexisNexis (TM) HEADNOTES - Core Concepts:

Civil Procedure > Summary Judgment > Summary Judgment Standard
Civil Procedure > Appeals > Standards of Review > De Novo Review

[HN1] An appellate court reviews a district court's grant of summary judgment without deference. Thus, the court must decide for itself if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving

party is entitled to a judgment as a matter of law. *Fed. R. Civ. P. 56(c)*. In so doing, the court draws all justifiable inferences in the nonmovant's favor.

Patent Law > Infringement > Claim Interpretation
Patent Law > Jurisdiction & Review > Standards of Review

[HN2] Before determining whether an accused device or process infringes, a court must first construe the claim language to determine the meaning and scope of the claims. Claim language defines claim scope. Generally, claim language receives its plain, ordinary meaning as used in the relevant art. When construing claim scope, courts may consult the specification, the prosecution history, and other relevant evidence. Claim construction is a question of law, which an appellate court reviews without deference.

Patent Law > Infringement > Claim Interpretation

[HN3] Whether to treat a preamble as a limitation is a determination resolved only on review of the entire patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.

Patent Law > Infringement > Claim Interpretation

[HN4] Whether a preamble stating the purpose and context of the invention constitutes a limitation of the claimed process is determined on the facts of each patent case in light of the overall form of the claim, and the invention as described in the specification and illuminated in the prosecution history.

Patent Law > Infringement > Claim Interpretation

[HN5] In general, in patent cases, a preamble limits the invention if it recites essential structure or steps, or if it is necessary to give life, meaning, and vitality to the claim. Conversely, a preamble is not limiting where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention. No litmus test defines when a preamble limits claim scope.

Patent Law > Infringement > Claim Interpretation

[HN6] In patent cases, Jepson claiming generally indicates intent to use the preamble to define the claimed invention, thereby limiting claim scope. Additionally, dependence on a particular disputed preamble phrase for antecedent basis may limit claim scope because it indicates a reliance on both the preamble and claim body to define the claimed invention.

Patent Law > Infringement > Claim Interpretation

[HN7] When the claim drafter chooses to use both the preamble and the body to define the subject matter of the

claimed invention, the invention so defined, and not some other, is the one the patent protects. When the preamble is essential to understand limitations or terms in the claim body, the preamble limits claim scope.

Patent Law > Infringement > Claim Interpretation

[HN8] When reciting additional structure or steps underscored as important by the specification, the preamble of a patent claim may operate as a claim limitation.

Patent Law > Infringement > Claim Interpretation

[HN9] In patent cases, clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention. Without such reliance, however, a preamble generally is not limiting when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention.

Patent Law > Infringement > Claim Interpretation

[HN10] A preamble of a patent claim may limit when it is employed to distinguish a new use of a prior art apparatus or process.

Patent Law > Infringement > Claim Interpretation

[HN11] In patent cases, preamble language merely extolling benefits or features of the claimed invention does not limit the claim scope without clear reliance on those benefits or features as patentably significant.

Patent Law > Infringement > Claim Interpretation

[HN12] Preambles describing the use of an invention generally do not limit the claims because the patentability of apparatus or composition claims depends on the claimed structure, not on the use or purpose of that structure.

Patent Law > Infringement > Claim Interpretation

[HN13] It is trite to state that the patentability of apparatus claims must be shown in the structure claimed and not merely upon a use, function, or result thereof.

Patent Law > Infringement > Claim Interpretation

[HN14] The inventor of a machine is entitled to the benefit of all the uses to which it can be put, no matter whether he had conceived the idea of the use or not. More specifically, this means that a patent grants the right to exclude others from making, using, selling, offering to sale, or importing the claimed apparatus or composition for any use of that apparatus or

composition, whether or not the patentee envisioned such use. 35 U.S.C.S. § 271 (1994).

Patent Law > Nonobviousness > Tests & Proof of Obviousness

[HN15] Statements of intended use or asserted benefits in the preamble may, in rare instances, limit apparatus claims, but only if the applicant clearly and unmistakably relied on those uses or benefits to distinguish prior art. Likewise, this principle does not mean that apparatus claims necessarily prevent a subsequent inventor from obtaining a patent on a new method of using the apparatus where that new method is useful and nonobvious.

Patent Law > Nonobviousness > Tests & Proof of Obviousness

[HN16] If a previously patented device, in its normal and usual operation, will perform the function claimed in a subsequent process patent, then such process patent is anticipated by the former patented device.

Patent Law > Patentable Subject Matter > Processes

[HN17] See 35 U.S.C.S. § 101 (1994).

Patent Law > Patentable Subject Matter > Processes

[HN18] See 35 U.S.C.S. § 100(b) (1994).

Patent Law > Infringement > Claim Interpretation

[HN19] The ordinary meaning of "predesignated site" is to designate beforehand the original or fixed position of a thing, in the context of patent claims.

Patent Law > Infringement > Claim Interpretation

[HN20] The term, "such as," introduces an example of a broader genus rather than limiting the genus to the exemplary species, in the context of patent claims.

Patent Law > Infringement > Doctrine of Equivalents

[HN21] After claim construction, the fact finder compares the properly construed claims to the accused device or process. To prove infringement, the patentee must show that the accused device meets each claim limitation either literally or under the doctrine of equivalents. Literal infringement requires the patentee to prove that the accused device contains each limitation of the asserted claim. Infringement under the doctrine of equivalents requires the patentee to prove that the accused device contains an equivalent for each limitation not literally satisfied.

Patent Law > Infringement > Summary Judgment

[HN22] A determination of infringement, whether literal or under the doctrine of equivalents, is a question of fact. Summary judgment of no literal infringement is proper

when, construing the facts in a manner most favorable to the nonmovant, no reasonable jury could find that the accused system meets every limitation recited in the properly construed claims.

Patent Law > Infringement > Doctrine of Equivalents

[HN23] An accused device that does not literally infringe a claim may still infringe under the doctrine of equivalents if each limitation of the claim is met in the accused device either literally or equivalently. An element in the accused product is equivalent to a claim limitation if the differences between the two are "insubstantial" to one of ordinary skill in the art. Insubstantiality may be determined by whether the accused device performs substantially the same function in substantially the same way to obtain the same result as the claim limitation.

Patent Law > Infringement > Prosecution History Estoppel
Patent Law > Jurisdiction & Review > Standards of Review

[HN24] Prosecution history estoppel prevents the doctrine of equivalents from recapturing subject matter surrendered during prosecution. The relevant inquiry is whether a competitor would reasonably believe that the applicant had surrendered the relevant subject matter. The applicability of prosecution history estoppel is a legal question, which an appellate court reviews without deference.

COUNSEL: Steven Z. Szczepanski, Jenkins & Gilchrist, of Chicago, Illinois, argued for plaintiff-appellant. With him on the brief were Mary Jo Boldingh, Russell J. Genet, and Michael K. Nutter.

Dean D. Niro, Niro, Scavone, Haller & Niro, of Chicago, Illinois, argued for defendant-appellee. With him on the brief were Thomas G. Scavone and Christopher J. Lee.

JUDGES: Before MAYER, Chief Judge, RADER, and PROST, Circuit Judges.

OPINIONBY: RADER

OPINION: [*804]

RADER, Circuit Judge.

On summary judgment, the United States District Court for the Northern District of Illinois held that Coolsavings.com, Inc. (Coolsavings) did not infringe, either literally or by equivalents, the claims of Catalina Marketing International, Inc.'s (Catalina's) U.S. Patent No. 4,674,041 (the '041 patent). *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 2001 U.S. Dist. LEXIS 3781, slip op. at 6-7 (N.D. Ill. Mar. 27, 2001). In the

alternative, the district court applied prosecution history estoppel to bar Catalina from seeking equivalents on the location of [**2] the claimed terminals. Id. Because the district court erroneously relied on non-limiting language in the preamble of Claim 1 and misapplied prosecution history estoppel, this court affirms-in-part, reverses-in-part, vacates-in-part, and remands. [*805]

I.

The '041 patent, filed on September 15, 1983, claims a selection and distribution system for discount coupons. In a preferred embodiment, the system dispenses coupons to consumers at remote, kiosk-like terminals connected to a central host computer system. When a consumer activates the terminal in a retail outlet, the terminal displays available coupons on the screen. The consumer selects a coupon and a printer connected to the terminal prints it. The terminal selectively communicates with the central computer system to acquire coupon information for display. When the number of dispensed coupons for a certain product reaches a limit specified by a coupon provider, the central computer system stops providing that particular coupon. Figure 3a depicts the terminal:

[SEE FIGURE 3a IN ORIGINAL]

There are two independent claims at issue, namely Claims 1 and 25, which read as follows:

1. A system [sic] for controlling the selection [**3] and dispensing of product coupons at a plurality of remote terminals located at predesignated sites such as consumer stores wherein each terminal comprises:

activation means for activating such terminal for consumer transactions;

display means operatively connected with said activation means for displaying a plurality of coupons available for selection;

selection means operatively connected with said display means provided to permit selection of a desired displayed coupon by the consumer;

print means operatively connected with said selection means for printing and dispensing the coupon selected by the consumer; and control means operatively connected with said display means for monitoring each consumer transaction and for controlling said display means to prevent the display of coupons having

exceeded prescribed coupon limits. [*806]

25. A system for controlling the selection and dispensing of product coupons at a plurality of remote terminals located at predesignated sites such as consumer stores, comprising:

a plurality of free standing coupon display terminals located at predesignated sites such as consumer stores, each of said terminals being adapted for bidirectional [**4] data communication with a host central processing unit;

each of said terminals comprising activation means for activating such terminals for consumer use by insertion of a credit card or other card having customer account information stored on a magnetic strip;

display means operatively connected with said activation means for displaying a plurality of coupons;

selection means operatively connected with said display means for providing for the selection of a desired displayed coupon by a consumer;

print means operatively connected with said selection means for printing and dispensing the coupons selected;

terminal control means operatively connected with said display means and print means for continuously monitoring each customer transaction and for controlling said display and print means in response to prescribed coupon limits;

means for storing consumer transactions and for periodically communicating customer transactions to said host central processing unit;

said host central processing unit including means for the transmitting to each terminal particular information for each coupon; and said host central processing unit further including means for periodically transmitting [**5] to each terminal coupon limits such as and including expiration date, and total number of coupons to be dispensed.

'041 patent, col. 30, ll. 46-65 and col. 32, l. 67 - col. 33, l. 36 (emphases added).

During prosecution of the '041 patent, the examiner rejected all of the original claims as obvious in light of U.S. Patent No. 4,449,186 (the Kelley patent), which disclosed a terminal system for dispensing airline tickets. The examiner concluded that the only difference between the applicants' claimed invention and the Kelley patent was the location of the coupon terminal. In response, the applicants provided a general overview of the invention and amended the structural limitations of Claims 1 and 25 to distinguish the Kelley patent. The examiner again rejected all of the pending claims.

Responsive to the second rejection, the applicants again amended Claims 1 and 25, and submitted several declarations to bolster their assertion of nonobviousness. The applicants did not amend the claim language relating to the location of the terminals. Although stating that their invention involved terminals "located in stores" for the dispensing of coupons "on-site," the applicants also [**6] did not argue that the location of the terminals in stores distinguished the invention from the Kelley patent.

Coolsavings uses a web-based coupon system to monitor and control the distribution of coupons from its www.coolsavings.com website. After registering with the coolsavings.com website and providing demographic data, users can browse the website for available coupons. Users then select and print coupons for in-store redemption. Additionally, in some cases, users may access a coupon provider's website for on-line redemption of a coupon offer for on-line products. A centralized computer system stores coupon and user data. Users may access the Coolsavings [*807] system from any Internet-accessible computer by simply logging onto the coolsavings.com website. Coolsavings received U.S. Patent No. 5,761,648 (the '648 patent) for its web-based coupon system. Catalina's '041 patent was cited during prosecution of the '648 patent.

Catalina sued Coolsavings, alleging that Coolsavings' web-based coupon system infringed the '041 patent. The district court construed the claim language "located at predetermined sites such as consumer stores," and held that Coolsavings did not infringe, either [**7] literally or by equivalents, the construed language. After determining that Coolsavings did not infringe under the doctrine of equivalents, the district court then alternatively held that prosecution history estoppel barred Catalina from seeking equivalents on the location of the terminals.

On appeal, Catalina argues that the disputed language, which appears only in the preamble of Claim 1, is not a limitation because it merely states an intended use for the claimed system. Alternatively, Catalina contends that the district court misconstrued the "located at predetermined sites such as consumer stores" claim

language. In addition, Catalina asserts that prosecution history estoppel does not bar equivalents when the applicants did not amend the disputed language or argue patentability based on that language. This court has jurisdiction under 28 U.S.C. § 1295(a)(1) (1994).

II.

[HN1] This court reviews a district court's grant of summary judgment without deference. *Johns Hopkins Univ. v. Cellpro, Inc.*, 152 F.3d 1342, 1353, 47 USPQ2d 1705, 1713 (Fed. Cir. 1998). Thus, this court must decide for itself "if the pleadings, depositions, answers to interrogatories, [**8] and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." *Fed. R. Civ. P. 56(c)*; *Celotex Corp. v. Catrett*, 477 U.S. 317, 322, 91 L. Ed. 2d 265, 106 S. Ct. 2548 (1986). In so doing, this court draws all justifiable inferences in the nonmovant's favor. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255, 91 L. Ed. 2d 202, 106 S. Ct. 2505 (1986).

[HN2] Before determining whether an accused device or process infringes, a court must first construe the claim language to determine the meaning and scope of the claims. *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454, 46 USPQ2d 1169, 1172 (Fed. Cir. 1998) (en banc). Claim language defines claim scope. *SRI Int'l. v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (en banc). Generally, claim language receives its plain, ordinary meaning as used in the relevant art. *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999). When construing [**9] claim scope, courts may consult the specification, the prosecution history, and other relevant evidence. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1309, 51 USPQ2d 1161, 1169 (Fed. Cir. 1999). Claim construction is a question of law, which this court reviews without deference. *Cybor Corp.*, 138 F.3d at 1456.

A.

The district court's claim construction focused solely on the phrase "located at predetermined sites such as consumer stores." This phrase appears in the preamble of Claim 1, and in both the preamble and body of Claim 25. The district court construed this disputed phrase without discussion as to whether the [*808] phrase, which appears only in the preamble of Claim 1, was indeed a limitation of Claim 1.

[HN3] Whether to treat a preamble as a limitation is a determination "resolved only on review of the entire[] . . . patent to gain an understanding of what the inventors actually invented and intended to encompass by the

claim." *Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989); see also *Applied Materials, Inc. v. Advanced Semiconductor Materials Am., Inc.*, 98 F.3d 1563, 1572-73, 40 USPQ2d 1481, 1488 (Fed. Cir. 1996) [**10] [HN4] ("Whether a preamble stating the purpose and context of the invention constitutes a limitation of the claimed process is determined on the facts of each case in light of the overall form of the claim, and the invention as described in the specification and illuminated in the prosecution history.").

[HN5] In general, a preamble limits the invention if it recites essential structure or steps, or if it is "necessary to give life, meaning, and vitality" to the claim. *Pitney Bowes*, 182 F.3d at 1305. Conversely, a preamble is not limiting "where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention." *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997).

No litmus test defines when a preamble limits claim scope. *Corning Glass*, 868 F.2d at 1257. Some guideposts, however, have emerged from various cases discussing the preamble's effect on claim scope. For example, this court has held that [HN6] Jepson claiming generally indicates intent to use the preamble to define the claimed invention, thereby limiting claim scope. *Rowe*, 112 F.3d at 479; [**11] *Epcon Gas Sys., Inc. v. Bauer Compressors, Inc.*, 279 F.3d 1022, 1029, 61 USPQ2d 1470, 1475 (Fed. Cir. 2002). Additionally, dependence on a particular disputed preamble phrase for antecedent basis may limit claim scope because it indicates a reliance on both the preamble and claim body to define the claimed invention. *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995) [HN7] ("When the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects."). Likewise, when the preamble is essential to understand limitations or terms in the claim body, the preamble limits claim scope. *Pitney Bowes*, 182 F.3d at 1306.

Further, [HN8] when reciting additional structure or steps underscored as important by the specification, the preamble may operate as a claim limitation. *Corning Glass*, 868 F.2d at 1257 (limiting claim scope to "optical waveguides" rather than all optical fibers in light of specification); *General Electric Co. v. Nintendo Co.*, 179 F.3d 1350, 1361-62, 50 USPQ2d 1910, 1918-19 (Fed. Cir. 1999) [**12] (limiting claim scope to a "raster scanned display device" rather than all display systems in view of specification's focus on the prior art problem of displaying binary data on a raster scan display device);

Rowe, 112 F.3d at 479-80; *Applied Materials*, 98 F.3d at 1573.

Moreover, [HN9] clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention. See generally *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1375, 58 USPQ2d 1508, 1513 [*809] (Fed. Cir. 2001) [HN10] (A preamble may limit when employed to distinguish a new use of a prior art apparatus or process.). Without such reliance, however, a preamble generally is not limiting when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention. *IMS Tech., Inc. v. Haas Automation, Inc.*, 206 F.3d 1422, 1434, 54 USPQ2d 1129, 1136-37 (Fed. Cir. 2000) (preamble phrase "control apparatus" [**13] does not limit claim scope where it merely gives a name to the structurally complete invention). Thus, [HN11] preamble language merely extolling benefits or features of the claimed invention does not limit the claim scope without clear reliance on those benefits or features as patentably significant. *STX, LLC v. Brine, Inc.*, 211 F.3d 588, 591 (Fed. Cir. 2000) (preamble stating that invention provides "improved playing and handling characteristics" is not a limitation); *Bristol-Myers*, 246 F.3d at 1375 (steps of claimed method are performed the same way regardless of whether, as stated in the preamble, a reduction of hematologic toxicity occurs).

Moreover, [HN12] preambles describing the use of an invention generally do not limit the claims because the patentability of apparatus or composition claims depends on the claimed structure, not on the use or purpose of that structure. *In re Gardiner*, 36 C.C.P.A. 748, 171 F.2d 313, 315-16, 80 USPQ 99, 101 (CCPA 1948) [HN13] ("It is trite to state that the patentability of apparatus claims must be shown in the structure claimed and not merely upon a use, function, or result thereof."). Indeed, [HN14] "the inventor of [**14] a machine is entitled to the benefit of all the uses to which it can be put, no matter whether he had conceived the idea of the use or not." *Roberts v. Ryer*, 91 U.S. 150, 157, 23 L. Ed. 267 (1875). More specifically, this means that a patent grants the right to exclude others from making, using, selling, offering to sale, or importing the claimed apparatus or composition for any use of that apparatus or composition, whether or not the patentee envisioned such use. See 35 U.S.C. § 271 (1994). Again, [HN15] statements of intended use or asserted benefits in the preamble may, in rare instances, limit apparatus claims, but only if the applicant clearly and unmistakably relied on those uses or benefits to distinguish prior art.

Likewise, this principle does not mean that apparatus claims necessarily prevent a subsequent inventor from obtaining a patent on a new method of using the apparatus where that new method is useful and nonobvious.

Perhaps a hypothetical best illustrates these principles: Inventor A invents a shoe polish for shining shoes (which, for the sake of example, is novel, useful, and nonobvious). Inventor A receives a patent having composition [**15] claims for shoe polish. Indeed, the preamble of these hypothetical claims recites "a composition for polishing shoes." Clearly, Inventor B could not later secure a patent with composition claims on the same composition because it would not be novel. See *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Likewise, Inventor B could not secure claims on the method of using the composition for shining shoes because the use is not a "new use" of the composition but, rather, the same use - shining shoes. See *Bristol-Myers*, 246 F.3d at 1375; *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986).

Suppose Inventor B discovers that the polish also repels water when rubbed onto shoes. Inventor B could not likely claim a method of using the polish to repel water on shoes because repelling water is inherent in the normal use of the polish to shine shoes. *Id.* at 1326 [HN16] ("If a previously patented device, in its normal and usual [*810] operation, will perform the function [claimed] in a subsequent [] process patent, then such [] process patent [is] . . . anticipated by the former patented [**16] device.") (quoting *In re Ackenback*, 45 F.2d 437, 439, 7 USPQ 268, 270 (CCPA 1930)); see also *Bristol-Myers*, 246 F.3d at 1375. In other words, Inventor B has not invented a "new" use by rubbing polish on shoes to repel water. Upon discovering, however, that the polish composition grows hair when rubbed on bare human skin, Inventor B can likely obtain method claims directed to the new use of the composition to grow hair. See 35 U.S.C. § 101 (1994) [HN17] ("Whoever invents or discovers any new and useful process . . . may obtain a patent therefor."); 35 U.S.C. § 100(b) (1994) [HN18] ("The term 'process' means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material."). Hence, while Inventor B may obtain a blocking patent on the use of Inventor A's composition to grow hair, this method patent does not bestow on Inventor B any right with respect to the patented composition. Even though Inventor A's claim recites "a composition for polishing shoes," Inventor B cannot invoke this use limitation to limit Inventor A's composition claim because that preamble [**17] phrase states a use or purpose of the

composition and does not impose a limit on Inventor A's claim.

In this case, the claims, specification, and prosecution history of the '041 patent demonstrate that the preamble phrase "located at predesignated sites such as consumer stores" is not a limitation of Claim 1. The applicant did not rely on this phrase to define its invention nor is the phrase essential to understand limitations or terms in the claim body. Although the specification refers to terminals located at points of sale, and even once states that terminals may be placed in retail stores, the specification, in its entirety, does not make the location of the terminals an additional structure for the claimed terminals. See '041 patent, col. 1, l. 67 - col. 2, l. 37 and col. 4, ll. 65-67.

The applicants also did not rely on the preamble phrase to distinguish over the Kelly patent. Rather, the examiner expressly rejected the claims on the basis that the location of the terminals in stores was not patentably significant. In response, the applicants amended structural limitations in the claim body to distinguish the Kelly patent. Thus, while the applicants stated during prosecution [**18] that their invention involved terminals "located in stores" for the dispensing of coupons "on-site," such statements, without more, do not indicate a clear reliance on the preamble to distinguish the prior art, especially where the examiner's initial rejection considered terminal location insignificant for patentability.

Moreover, deletion of the disputed phrase from the preamble of Claim 1 does not affect the structural definition or operation of the terminal itself. The claim body defines a structurally complete invention. The location of the terminals in stores merely gives an intended use for the claimed terminals. As already noted, the applicants did not rely on this intended use to distinguish their invention over the prior art.

In this case, the disputed preamble language does not limit Claim 1 -- an apparatus claim. To hold otherwise would effectively impose a method limitation on an apparatus claim without justification. Accordingly, this court holds that the district court erroneously treated the preamble as a limitation of Claim 1.

B.

While the phrase "located at predesignated sites such as consumer [*811] stores" appears only in the preamble of Claim 1, this language appears [**19] in both the preamble and body of Claim 25. Hence, the applicants specifically included this language in the claim not once, but twice. By virtue of its inclusion in the body of Claim 25, this phrase limits Claim 25. This court, therefore, must determine whether the district

court's construction of the disputed phrase is correct as a matter of law.

In interpreting this language, the district court found that "predesignate" means "to designate beforehand," and that "site" means "the original or fixed position of a thing." Accordingly, the district court held that the ordinary meaning of "predesignated site" is "to designate beforehand the original or fixed position of a thing." The district court found that the term "such as" means "of a kind or character about to be indicated, suggested, or exemplified; for instance." The district court then considered whether the phrase "such as a consumer store" means that the terminals may be located anywhere or only "at the point of sale." The district court concluded that the terminals had "to be placed at a predesignated site at the point of sale, i.e., a consumer store."

Although agreeing with the dictionary definition of "predesignated site, [**20]" Catalina argues that the predesignation of sites refers to "the connecting of and accepting of the terminal by the host computer." According to Mr. Wicker, Catalina's expert, "predesignated sites" "indicates that certain sites have been designated, and [] that they have been designated at a point in time prior to . . . 'the selection and dispensing of product coupons.'" Catalina further contends that the district court erred by equating "point of sale" with "consumer store." According to Catalina, the genus indicated by the species "consumer stores" is a "point of sale" location.

The district court correctly held that [HN19] the ordinary meaning of "predesignated site" is "to designate beforehand the original or fixed position of a thing." Thus, the claim requires designation of a terminal site before location of a terminal at that site. Catalina's argument that "predesignated sites" refers to the recognition of a terminal by a host computer at some point before coupon selection ignores the physical dimension indicated by the phrase "located at" immediately preceding "predesignated sites." Recognition simply does not amount to predesignation. Thus, a coupon dispensing entity must designate [**21] a location for a terminal before placing it at that site. This claim language limits the scope of the claims.

The district court correctly found that the term "such as" means "of a kind or character about to be indicated, suggested, or exemplified; for instance." Despite correctly characterizing "such as" as exemplary language, the district court erroneously equated "point of sale" with "consumer store." [HN20] "Such as" introduces an example of a broader genus rather than limiting the genus to the exemplary species. Moreover, the specification of the '041 patent uses the phrase "such

as consumer stores" as an example of a possible point of sale location. See, e.g., '041 patent, col. 1, l. 67 - col. 2, l. 4, col. 2, ll. 32-38, and col. 4, ll. 65-67. As discussed above, the applicants stated during prosecution that their invention involved terminals "located in stores" for the dispensing of coupons "on-site." This descriptive language during the acquisition of the patent does not make the store location more than an example of a point of sale location.

This court thus holds that the phrase "located at predesignated sites such as consumer stores" requires designation of the physical [**22] site of the terminal before [**812] location of the terminal at a point of sale location.

III.

[HN21] After claim construction, the fact finder compares the properly construed claims to the accused device or process. *Cybor Corp.*, 138 F.3d at 1454. To prove infringement, the patentee must show that the accused device meets each claim limitation either literally or under the doctrine of equivalents. *Seal-Flex, Inc. v. Athletic Track and Court Const.*, 172 F.3d 836, 842, 50 USPQ2d 1225, 1228 (Fed. Cir. 1999). Literal infringement requires the patentee to prove that the accused device contains each limitation of the asserted claim. *Mas-Hamilton Group v. LaGard, Inc.*, 156 F.3d 1206, 1211, 48 USPQ2d 1010, 1014-15 (Fed. Cir. 1998). Infringement under the doctrine of equivalents requires the patentee to prove that the accused device contains an equivalent for each limitation not literally satisfied. *Dawn Equip. Co. v. Kentucky Farms*, 140 F.3d 1009, 1015, 46 USPQ2d 1109, 1113 (Fed. Cir. 1998).

[HN22] A determination of infringement, whether literal or under the doctrine of equivalents, is a question of fact. *Bai v. L & L Wings, Inc.*, 160 F.3d 1350, 1353, 48 USPQ2d 1674, 1676 (Fed. Cir. 1998). [**23] Summary judgment of no literal infringement is proper when, construing the facts in a manner most favorable to the nonmovant, no reasonable jury could find that the accused system meets every limitation recited in the properly construed claims. *Bai*, 160 F.3d at 1353.

A.

Based on its construction of the phrase "located at predesignated sites such as consumer stores," the district court held that Coolsavings' system did not literally infringe Claims 1 or 25 of the '041 patent. Because this phrase does not limit Claim 1 and the district court did not further construe Claim 1, this court vacates the judgment of no literal infringement of Claim 1 and remands for claim construction and appropriate infringement proceedings. With respect to Claim 25, this court construed the phrase "located at predesignated sites

such as consumer stores" to require that the physical position of the terminal be designated before placement of the terminal at a point of sale location. For Coolsavings to be liable for literal infringement Coolsavings' accused system must designate the physical position of the terminals before location of the terminals at a point of sale. Coolsavings' system, [**24] however, does not designate (or even recognize) the physical position of computers connecting to its website; thus, Coolsavings' system does not literally satisfy this limitation of Claim 25. Under the proper claim construction, this court therefore affirms the district court's holding that Coolsavings' system does not literally infringe Claim 25 of the '041 patent. Because this holding is dispositive on literal infringement, this court need not opine on Catalina's argument that an Internet-accessible home computer constitutes a point of sale location.

B.

[HN23] "An accused device that does not literally infringe a claim may still infringe under the doctrine of equivalents if each limitation of the claim is met in the accused device either literally or equivalently." *Cybor Corp.*, 138 F.3d at 1459. An element in the accused product is equivalent to a claim limitation if the differences between the two are "insubstantial" to one of ordinary skill in the art. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 40, [*813] 137 L. Ed. 2d 146, 117 S. Ct. 1040 (1997). Insubstantiality may be determined by whether the accused device "performs substantially the [**25] same function in substantially the same way to obtain the same result" as the claim limitation. *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608, 94 L. Ed. 1097, 70 S. Ct. 854 (1950).

Because the district court only construed a non-limiting preamble phrase and has not further construed the limitations of Claim 1, this court vacates and remands for further proceedings concerning infringement under the doctrine of equivalents on Claim 1. The record evidence does not sufficiently inform as to whether Coolsavings' system varies insubstantially from Claim 25's requirement of terminals "located at predesignated sites such as consumer stores." In other words, the doctrine of equivalents requires a factual assessment of whether Coolsavings' system, which of necessity determines an Internet address for computers accessing its website, is insubstantially different from the placement of terminals at predesignated points of sale. This court, therefore, vacates and remands the question of infringement under the doctrine of equivalents on Claim 25.

IV.

[HN24] Prosecution history estoppel prevents the doctrine of equivalents from recapturing subject matter surrendered [**26] during prosecution. *Litton Sys., Inc. v. Honeywell, Inc.*, 140 F.3d 1449, 1458, 46 USPQ2d 1321, 1327 (Fed. Cir. 1998). "The relevant inquiry is whether a competitor would reasonably believe that the applicant had surrendered the relevant subject matter." *Cybor Corp.*, 138 F.3d at 1457. The applicability of prosecution history estoppel is a legal question, which this court reviews without deference. *Id.* at 1460.

The district court concluded that prosecution history estoppel barred Catalina from seeking equivalents for the "located at predesignated sites such as consumer stores" limitation. While its analysis is somewhat unclear, the district court appears to base its conclusion on the applicants' statements during prosecution that their invention involved terminals "located in stores" for the dispensing of coupons "on-site."

As discussed above, the applicants did not amend this language regarding the location of the terminals. In addition, the applicants did not argue that the location of terminals would distinguish the invention from the prior art. Undeniably, such an argument would have failed given the examiner's express statement [**27] that terminal location was not significant to the patentability inquiry. In sum, the applicant did not, clearly or otherwise, surrender subject matter by making allusions to terminal location. This court, therefore, reverses the district court's holding that prosecution history estoppel bars Catalina from seeking equivalents on this missing limitation of Claim 25.

CONCLUSION

Because the district court erroneously relied on non-limiting language in the preamble of Claim 1, this court vacates the district court's judgment of non-infringement of Claim 1, both literally and by equivalents, to give the district court the opportunity to construe the limitations of Claim 1. Although the district court erred in its construction of Claim 25, because the accused system does not infringe literally Claim 25, as properly construed, this court affirms the holding of no literal infringement of Claim 25. This court vacates and remands the holding of no infringement of Claim 25 by equivalents because the trial court should have an opportunity to develop [*814] and assess the record under the proper claim construction. Finally, because the district court erred in determining that prosecution history estoppel [**28] bars equivalents on the terminal location, this court reverses that holding.

COSTS

Each party shall bear its own costs.

AFFIRMED-IN-PART, REVERSED-IN-PART, VACATED-IN-PART, and REMANDED.